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Paper No. 4

JUL 24 2003

Technology Center 2100

In re Application of: Tatebayashi et al.)
Application No. 09/638,616)
Attorney Docket No. NAKI-BM08)
Filed: August 15, 2000)
For: ENCRYPTION METHOD, ENCRYPTION)
APPARATUS, DECRYPTION METHOD, AND)
DECRYPTION APPARATUS)
) DECISION ON PETITION TO MAKE
) SPECIAL UNDER 37 CFR §1.102(d) –
) ACCELERATED EXAMINATION

This is a decision on the petition, filed June 27, 2003 under 37 CFR §1.102(d), in accordance with MPEP 708.02(VIII), requesting the Accelerated Examination of the above-identified application.

The petition is DISMISSED.

MPEP § 708.02, Section VIII, sets out the prerequisites to be met by applicant for a grantable petition for Accelerated Examination under 37 CFR §1.102(d), as follows:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention. If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;

- (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

As for requirement (A), the required petition fee was paid on June 24, 2003.

As for requirement (B), petitioner has made no statement that all the claims are directed to a single invention. Since there are several independent claims, each having a different scope, it will be up to the examiner to make such a determination. Applicant has made no provision for the possibility of a restriction requirement by the examiner. Applicant must provide the following statement as a prerequisite to a grant of special status: "If the Office determines that all claims presented are not obviously directed to a single invention, applicant will make an election without traverse and will follow established telephone restriction practice to make such an election if requested to do so."

As for requirement (C), petitioner has not listed the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. Furthermore, no copy of the search made by a European search report has been included to satisfy this requirement.

As for requirement (D), petitioner has not submitted one copy of each of the references noted in the petition. Only the reference EP 0 874 496 has been submitted (in an Information Disclosure Statement filed on November 27, 2001).

As for requirement (E), petitioner has not provided a detailed discussion that points out, *with the particularity required by 37 CFR 1.111(b) and (c)*, how the claimed subject matter is patentable over the references. For each of the references cited, applicant must clearly show how each of the cited references is deficient in teaching *or suggesting* specific language of the claims. The summary of the three references followed by a paraphrase of the claims does not meet the requirements of 37 CFR 1.111(b)-(c).

Therefore, the Petition is **DISMISSED**.

On July 10, 2003, Joseph W. Price (Reg. No. 25,124) was contacted regarding an earlier version (June 24, 2003) of the petition mentioned on the cover sheet of the June 27, 2003 petition. Mr. Price indicated that all of the references had been mailed with the June 24, 2003 petition, however, this version is missing from the application papers. A perfected request to make special must include full copies of both the Stallings Williams and the Charnes, et al. articles.

The application file will be forwarded to the Central Files of Technology Center 2100 to await examination in its proper turn based on its effective filing date. Petitioner is entitled to one opportunity to perfect the request in a renewed petition to make special. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.


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